



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/574,697	05/17/2000	Paul W. Chau	SPY-022-C1	8633

7590
David R Graham
1337 Chewpon Ave
Milpitas, CA 95035

06/15/2004

EXAMINER

NGUYEN, VAN H

ART UNIT	PAPER NUMBER
----------	--------------

2126

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/574,697

Applicant(s)

CHAU ET AL.

Examiner

VAN H NGUYEN

Art Unit

2126

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 10-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/15/00; 4/20/01; 4/19/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election of group I (claims 1-9), filed April 12, 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 1-40 are pending in this application. Claims 10-14 are withdrawn from consideration.
3. Applicant is required to cancel non-elected claims 10-40 in the next response to this office action.

Specification

4. The abstract of the disclosure is objected to because it **exceeds the limit of 150 words**. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 2126

6. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "said mode of operation" (claim 1, line 13) lacks antecedent basis:

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Wilkinson et al.** (U.S. 6,308,317).

9. As to claim 1, Wilkinson teaches the invention substantially as claimed including a system for an integrated circuit card interface device, the interface device operable in one or more modes of operation (*abstract and fig. 1*), comprising:

- an application memory (*e.g., EEPROM, ROM; col.7, lines 43-55 and col.12, lines 49-64*);
- an application engine (*e.g., a card virtual machine; col.8, lines 20-22*) for managing one or more applications (*e.g., applications; col.8, lines 20-22*) in the application memory;
- an input/output module (*e.g., I/O; col.12, lines 20-25*);

Art Unit: 2126

- a host interface (*e.g., terminal communicator 12b; fig. 1*);
- one or more integrated circuit card interfaces (*e.g., communicator 12a; fig. 1*);
- an input unit (*e.g., receiving commands from the user; col.12, lines 43-48*);

wherein the application engine interacts with the input/output module appropriate to the mode of operation to interface with an integrated circuit card operably connected to the interface device (*e.g., the selected Java card application 126z communicates with an appropriate application in the terminal 14 using the communicator 12a to establish a communication channel to the terminal 14... receiving responses from the Java card application 126z, which are processed and passed back to the user; col.12, lines 26-48*).

Wilkinson does not specifically use the phrase “a display unit.” Wilkinson, however, discloses “*the terminal application interacts with the user, receiving command from the user...passed back to the user*” (col. 12, lines 43-48).

It would have been obvious to one of ordinary skill in the art to have also included a display unit to Wilkinson’s system in order to provide means for the user to interact (send commands, view responses) with the terminal.

10. As to claim 2, Wilkinson teaches the application memory further comprises a read-only memory (*e.g., ROM; col.7, lines 43-55 and col.12, lines 49-64*).

11. As to claim 3, Wilkinson teaches the application memory further comprises an electrically erasable programmable read-only memory (*e.g., EEPROM; lines 43-55 and col.12, lines 49-64*).

12. As to claim 4, Wilkinson teaches the application engine further comprises a microcontroller (*e.g., microcontroller; col.7, lines 43-55*).

Art Unit: 2126

13. As to claim 5, Wilkinson teaches the microcontroller further comprises the application memory (*col.7, lines 57-65*).

14. As to claim 6, Wilkinson teaches wherein the input/output module comprises a microcontroller (*e.g., microcontroller; col.7, lines 43-55*).

15. As to claim 7, Wilkinson teaches the application engine further comprises a custom circuit (*col.7, lines 57-65*).

16. As to claim 8, Wilkinson teaches the custom circuit further comprises the application memory (*e.g., memory; col.7, lines 57-65*).

17. As to claim 9, Wilkinson teaches the input/output module further comprises a custom circuit (*col.7, lines 57-65*).

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Shigenaga (US 4809326) discloses "IC card system."

- Chaney (US 5852290) discloses "Smart-card based access control system with improved security."

- Wentker et al. (US 6481632) discloses "Delegated management of smart card applications."

- Chaney et al. (US 6594361) discloses "High speed signal processing smart card."

Art Unit: 2126

- Markakis et al. (US 6742120) discloses "System and method for controlling access to computer code in an IC card."

- Guthery "Java card: Internet computing on a smart card" 1997 IEEE, pp. 57-59.

- Elliot et al. "Smart-card based electronic commerce: characteristics and roles" 1998 IEEE, pp. 1-9.

- Husemann "the smart card: don't leave home without it" 1999 IEEE, pp. 24-27.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VAN H NGUYEN whose telephone number is (703) 306-5971. The examiner can normally be reached on Monday-Thursday from 8:30AM - 6:00PM. The examiner can also be reached on alternative Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ming-Ai An can be reached on (703) 305-9678.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VHN

MENG-AL T. AN
SUPERVISORY PATENT EXAMINER
ELECTRONIC BUSINESS CENTER 2100

MENG-AL T. AN
SUPERVISORY PATENT EXAMINER
ELECTRONIC BUSINESS CENTER 2100